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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,054	06/24/2003	Patricia Chapman Irwin	839-1393	1053

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/604,054

Applicant(s)

IRWIN ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 and 51-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/24/03, 01/03/05, 01/04/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on January 4, 2005 is acknowledged.

### ***Specification***

2. The use of the trademark Ultem™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim s 5-7 and 38-50 contains the trademark/trade name Ultem™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe

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particular polymers forming the article (the examiner believes to be polyetherimides)

and, accordingly, the identification/description is indefinite.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-12 and 25-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-12 of copending Application No. 10/604055. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both contain slot armors formed with a second leg shorter and thicker than the first leg and slot armors formed of the same materials as instantly recited.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-12 and 25-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-22 of copending Application No. 10/915451. Although the conflicting claims are not

identical, they are not patentably distinct from each other because they both contain slot armors formed with a second leg shorter and thicker than the first leg and slot armors formed of the same materials as instantly recited.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Biglin et al (3634182).

Biglin et al discloses a structure containing a first leg portion 50, 51, 53 and a second leg portion 52 that is shorter and thicker than at least sections 50 and 53 of first leg portion. The second leg also forms an angle of less than 90 degrees with the first leg and tapers as the tip extends away from the connection portion. Refer to figure 9.

9. Claims 1, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara et al (5478627).

Hara et al disclose a structure containing a first leg portion 1, 2 and a second leg portion 3 that is shorter and thicker than the first leg portion. The second leg portion 3 contains a skeleton structure containing hollow sections 4. Refer to figures 1B and 3.

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10. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore (4469971).

Moore discloses a slot armor containing a first leg portion 14 and a second leg portion 12 that is shorter and thicker than the first leg portion. Refer to figure 2.

11. Claims 1, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Scherzinger et al (5698923).

Scherzinger et al discloses a slot armor containing a first leg portion 40 and a second leg portion 42,46 that is shorter and thicker than the first leg portion. The second leg portion contains a connection portion 42 that connects the first leg to the second leg and wherein the tip portion of the second leg 46 tapers. Refer to figure 2.

12. Claims 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by either Deridan (4633116 or 4709181).

Both references teach to form at least part of the slot member (i.e. top and bottom) of Ultem™. The reference would also read upon these claims since the claim appears to recite a material and no positive structure thereto. Refer to column 3, lines 13-65 in Deridan '116. Refer to column 2, lines 25-29 and column 4, lines 54-60 in Deridan '181.

13. Claims 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by either Miller (4833354) or Bryant (5319269).

Both references teach a PEEK material used in electric motors. These claims are rejected since they appear to recite a material and no positive structure thereto. Refer to the Abstract in each reference.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-4, 25-31 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherzinger et al in view of either Miller or Bryant.

Scherzinger et al teaches a slot liner of the recited structure containing the two leg portions as recited. Scherzinger et al fails to teach the structural liner formed of PEEK. Scherzinger et al does teach the liner formed of high temperature insulating materials (column 2, lines 39-44). See 35 USC 102 rejection above.

Both secondary references teach to form insulating parts in an electric motor of PEEK because of its durability in high temperature applications. See column 5, line 35 through column 6, line 44.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Scherzinger et al to form the structural liners of PEEK motivated by the fact that both secondary references teach to use this material in electric motor application for its superior durability under heat and other adverse conditions associated within the art.

16. Claims 5-7 and 38-44 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherzinger et al in view of either Deridan '181 or '116.

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Scherzinger et al teaches a slot liner of the recited structure containing the two leg portions as recited. Scherzinger et al fails to teach the structural liner formed of Ultem™. Scherzinger et al does teach the liner formed of high temperature insulating materials (column 2, lines 39-44). See 35 USC 102 rejection above.

Both secondary references teach to form insulating parts in an electric motor of Ultem™ because of its durability in high temperature applications. See column 3, lines 59-65 in Deridan '116.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Scherzinger et al to form the structural liners of Ultem™ motivated by the fact that both secondary references teach to use this material in electric motor application for its superior durability under heat and other adverse conditions associated within the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney  
Primary Examiner  
Art Unit 1772

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04/04/05